

Serial No. 10/657,524

Amdt. in Response to Office Action mailed Jan. 4, 2007

UTILITY PATENT

B&amp;D No. TN3481

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REMARKS

Applicant has amended Claim 1, and added Claim 18.

Currently pending in the application are Claims 1-9 and 17-18.

The Examiner objected to Claims 1, 6-9 and 17 due to some informalities. As to Claim 1, the Examiner pointed out that a comma should be inserted. The Examiner has pointed out that the status of Claim 17 should read "previously presented." Applicants have amended Claims 1 and 17 accordingly.

The Examiner rejected Claims 1, 6-9 and 17 under 35 USC § 112, first paragraph, as failing to comply with the description requirement. In particular, the Examiner alleges that the specification does not provide support for the limitation "an auxiliary fence... disposed above a portion of the fixed fence." Applicants respectfully disagree. As shown in FIG. 3, auxiliary fence 23S is higher (and thus above) fixed fence 21. Nonetheless, Applicants have amended Claim 1 to explicitly state that the auxiliary fence is higher than a highest point on the fixed fence.

The Examiner rejected Claims 1 and 6-9 under 35 USC 102(b) as anticipated by EP 0 752 300 ("EP '300"). Reconsideration and withdrawal of these rejections are respectfully requested.

Claim 1, as amended, calls for *inter alia* a fence assembly attached to the base. The fence assembly comprises a fixed fence fixedly attached to the base a movable fence removably connected to the fixed fence, the movable fence defining a first support plane, at least one of the fixed fence and the movable fence for contacting the workpiece, and an auxiliary fence disposed behind at least one of the fixed fence and the movable fence, the auxiliary fence being higher than a highest point on the fixed fence and defining a second support plane substantially parallel

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to the first support plane, so that when the movable fence is removed, no portion of the fence assembly is above the fixed fence and in front of the second support plane, allowing the auxiliary fence to contact the workpiece. The fixed fence, the movable fence and the auxiliary fence are disposed on one side of the blade.

The Examiner also has argued that EP '300 has a fixed fence 48, a movable fence 60, and an auxiliary fence 80 disposed behind the fixed and movable fences, the auxiliary fence 80 contacting the workpiece when the movable fence 60 is removed. Assuming for the sake of argument such interpretation is correct, EP '300 would still not teach Claim 1 as amended. That is because, even if flap 60 were to be removed from movable fence 32, movable fence 32 would still be in front of auxiliary fence 80.

By contradistinction, Claim 1 requires "an auxiliary fence disposed ... behind at least one of the fixed fence and the movable fence, the auxiliary fence being higher than a highest point on the fixed fence and defining a second support plane substantially parallel to the first support plane, so that when the movable fence is removed no portion of the fence assembly is above the fixed fence and in front of the second support plane, allowing the auxiliary fence to contact the workpiece."

The Examiner cannot ignore movable fence 32 in his analysis. Movable fence 32 is part of the fence assembly 30 disclosed in EP '300. EP '300, col. 5, lns. 22-24 ("According to the present invention, fence assembly 30 includes a first and a second movable fence 32 and 34..."). Being that EP '300 discloses a part of the fence assembly (movable fence 32) that would remain in front of the second support plane and is higher than the fixed fence 48, EP '300 cannot anticipate Claim 1 and its dependent claims.

Serial No. 10/657,524

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The Examiner rejected Claims 1 and 6-9 under 35 USC 103(a) as being unpatentable over US Patent No. 4,869,142 ("Sato") in view of US Patent No. 5,297,463 ("O'Banion") or EP '300. Reconsideration and withdrawal of these rejections are respectfully requested.

The Examiner has alleged that guard 37 in Sato is the claimed auxiliary fence disposed behind the fixed fence 3, when adjusted in such a manner. However, no *prima facie* case exists for such modification because, to use the unit as proposed by the Examiner, would render it unsatisfactory for its intended purpose.

If the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V).

In the present case, Sato teaches maintaining guard 37 coplanar with fixed fence 3. Sato, col. 5, lns. 28-30 & lns. 42-44 ("First, the knob 38 locks the guard 37 so that the workpiece support surface of the fence 3 and the edge of the guard 37 assume the same position"; "the guard 37 is retraced and fixed by the knob 38 in order to prevent the guard 37 from protruding from the workpiece support surface of fence 37"). Guard 37 is kept coplanar so that it can be used as a cutting line indicator when a workpiece is disposed against it. Sato, col. 5, lns. 32-35. If guard 37 were to be placed behind the fixed fence 3, the user would not be able to use guard 37 as a cutting line indicator. Accordingly, the modification proposed by the Examiner renders Sato unsatisfactory for its intended purpose, i.e., having an accurate cutting line indicator. Therefore, no suggestion or motivation exists to adjust Sato as proposed by the Examiner.

The Examiner noted that "the specific position to which feature 37 is adjusted is considered to be a functional recitation of intended use of the device of Sato." Yes, guard 37 is adjustable. But

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B&amp;D No. TN3481

to what purpose? So that it can be used as a cutting line indicator when a workpiece is disposed against it. Sato, col. 5, lns. 32-35. Adjusting the guard 37 for some other purpose, such as that suggested by the Examiner, would frustrate that purpose and thus render Sato unsatisfactory for its intended purpose, i.e., having an accurate cutting line indicator.

Finally, even if Sato were to be combined with O'Banion or EP '300, the resulting combination would not result in the claimed invention. If a first line substantially perpendicular to the support plane were drawn from the guard 37 and a second line substantially parallel to the support plane and extending from the fixed fence, the two lines cannot intersect because Sato's guard 37 is not directly behind the fixed fence 3. Even if the O'Banion or EP '300 fences were substituted, the first and second lines would still not intersect because the guard 37 is not directly behind the fixed fence portions.

By contradistinction, Claim 1 requires that "a first line extending substantially perpendicular to the second support plane from the auxiliary plane will contact the movable fence at a contact point, and a second line extending substantially parallel to the second support plane from the fixed fence will intersect the first line." Being that the Sato/O'Banion and Sato/EP '300 combinations do not have such arrangement, they cannot render unpatentable Claim 1 and its dependent claims.

In view of the foregoing, Claims 1-9 and 17-18 are patentable and the application is believed to be in condition for formal allowance.

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B&D No. TN3481

No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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